

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte J. EVAN JOHNSON,
KURT BAUMAN and DAVID L. SMITH

Appeal No. 98-0409
Application 08/420,480¹

ON BRIEF

Before CALVERT, MEISTER and STAAB, **Administrative Patent Judges**.

MEISTER, **Administrative Patent Judge**.

DECISION ON APPEAL

J. Evan Johnson, Kurt Bauman and David L. Smith (the appellants) appeal from the final rejection of claims 1-5, 7, 9-11 and 14-19, the only claims remaining in the application.

¹ Application for patent filed April 12, 1995.

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We **AFFIRM-IN-PART**.

The appellants' invention pertains to a cartridge holder system and apparatus. Independent claims 1, 10 and 15 are further illustrative of the appealed subject matter and copies thereof may be found in the appendix to the brief.

The references relied on by the examiner are:

Goss	162,055	Apr. 13, 1875
Benwald	3,668,802	June 13, 1972
Peckels et al. (Peckels)	5,186,326	Feb. 16, 1993

Claims 1-3, 5, 7, 9-11 and 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Goss. According to the examiner:

Goss discloses a holder system including a rack portion (A and P), a plurality of rigid receivers (D), and a cooperating sliding engagement member (B, i, i). The belt portion A provides the flexible integral border portion while the portion P provides the centrally positioned segment. Goss does not disclose the device as being made of plastic. Official notice is given that plastic material is widely used in place of leather and metal for allowing molding of parts and cheaper costs and can be made thin and flexible or thick and rigid. It would have been obvious to make the device of Goss from plastic for allowing molding of parts and cheaper costs. The cartridge receiver is removable and replaceable from the rack portion in the opposite manner in which they are assembled. Regarding claims 2, 20, and 11, the segments as

claimed are formed by A and P as indicated on page 1 column 2 lines 8-11 in that the portion P may be made of multiple parts as they are noted as being located at convenient distances on the belt A. For claim 3, it would have been obvious to reverse the orientation of the tracks as a matter of design choice achieving no new or unexpected results. Regarding claim[s] 5 and 7 it would have been obvious to replace some of the cartridge holders with other well known holders such as a closable case when it is desired to carry other articles. Regarding claim 9, as the device of Goss is used by a hunter, the belt will be attached to the clothes of the hunter and thus attached to hunting apparel. [Answer pages 3 and 4.]

Claims 4 and 15-19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Goss in view of Benward and Peckels. The examiner is further of the opinion that it would have been obvious to provide the receiver of Goss with a tab in view of the teachings of Benward and Peckels in order to provide "for better retention of the article in the bore" (answer, page 4).

The arguments of the appellants and examiner in support of their respective positions may be found on pages 4-11 of the brief and pages 4-7 of the answer.

OPINION

As a preliminary matter, we note that the brief contains arguments concerning the propriety of the examiner entering a

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final rejection. Under 35 U.S.C. § 134 and 37 CFR § 1.191, appeals to the Board of Patent Appeals and Interferences are taken from the decision of the primary examiner to reject claims. We exercise no general supervisory power over the examining corps and the decision of a primary examiner to make a particular Office action final is not subject to our review. **See Manual of Patent Examining Procedure** (MPEP) §§ 706.07(c) and 1002.02(c) (6th ed., Rev. 3, Jul. 1997); see **Ex parte Jackson**, 1926 C.D. 102, 104 (Comr. 1924). Thus, the relief sought by the appellants should have properly been presented by a petition to the Commissioner under 37 CFR § 1.181.

We have carefully reviewed the appellants' invention as described in the specification, the appealed claims, the prior art applied by the examiner and the respective positions advanced by the appellants in the brief and by the examiner in the answer. As a consequence of this review, we will sustain the rejections under 35 U.S.C. § 103 of claims 1-3, 5, 7 and 9 based on Goss and claims 4 and 15-19 based on the combined teachings of Goss and Benward. We will not, however, sustain the rejection under

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35 U.S.C. § 103 of claims 10, 11 and 14 based on Goss. Our reasons for these determinations follow.

The appellants have not separately argued the patentability of dependent claims 2-5, 7, 9, 11, 14 and 16-19 with an reason-able degree of specificity. Accordingly, these claims will stand or fall with the independent claim from which they depend. See 37 CFR § 1.192(c)(7) and *In re Nielson*, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987).

Considering first the rejection of claims 1-3, 5, 7 and 9 under 35 U.S.C. § 103 as being unpatentable over Goss, the appellants argue that "Goss does not disclose a centrally positioned segment with a integral border portion extending outwardly from said segment" (brief, page 6). We do not agree. As the examiner has noted, the clasps or slides P of Goss, in conjunction with the portion of the "ordinary belt" A (page 1, column 2, lines 4, 8 and 9) to which they are attached, can be considered to form the "segments." Clearly, the upper and lower portions of the belt A extend "outwardly" from the slides or clasps P (see, Fig. 3). As to the

limitation "integral," it is well settled that "'integral' is sufficiently broad to embrace constructions united by such means as fastening and welding,"

In re Hotte, 475 F.2d 644, 647, 177 USPQ 326, 329 (CCPA 1973).

See also Advanced Cardiovascular Sys., Inc. v. Scimed Life Sys., Inc., 887 F.2d 1070, 1072, 12 USPQ2d 1539, 1541 (Fed. Cir. 1989). Thus, the clasps or slides P of Goss, and the portion of the belt A to which they are fastened together by rivets (see Fig. 3), can be considered to be "integral" as claimed.

The appellants also "take issue with [the] Examiner's official notice that plastic material may be used in place of leather and metal" (brief, page 6). We must point out, however, that artisans must be presumed to know something about the art apart from what the references disclose (***see In re Jacoby***, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962)) and the conclusion of obviousness may be made from "common knowledge and common sense" of the person of ordinary skill in the art (***see***

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In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)). Moreover, skill is presumed on the part of those practicing in the art. **See In re Sovish**, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985). Therefore, the respective advantages and disadvantages of well-known materials used in the belt and holder art such as plastic, metal and leather would have been apparent to the artisan (note **In re Heinrich**, 268 F.2d 753, 756, 122 USPQ 388, 390 (CCPA 1959)) and, accordingly, we perceive that the selection of well-known materials having properties which are well-known in the belt and holder art (such as plastic) would have been obvious (**see In re Leshin**, 277 F.2d 197, 199, 125 USPQ 416, 418 (CCPA 1960)).

It is also the appellants' contention that claim 1 requires that "each receiver of Appellants' invention is removable and replaceable" (brief, page 7). This is not the case. Independent claim 1 more broadly recites that "the cartridge receiver may be slidably engaged with the rack portion and is removable and replaceable therefrom." This being the case, this limitation does not define over the

arrangement of Goss wherein all of the cartridge receivers are slidably engaged with the rack portion and are all removable and replaceable together as a unit.

The appellants also contend that they "were able to solve problems that were never addressed by Goss" (brief, page 9). We must point out, however, that all the utilities or benefits of the claimed invention need not be explicitly disclosed by the prior art references to render the claim unpatentable under section 103 (***see In re Dillon***, 919 F.2d 688, 692, 696, 16 USPQ2d 1897, 1901, 1904 (Fed. Cir. 1990) (in banc). ***See also In re Kemps***, 97 F.3d 1427, 40 USPQ2d 1309, 1311 (Fed. Cir. 1996) ("all the benefits of the claimed invention need not be explicitly disclosed to render the claim unpatentable under section 103").

In view of the foregoing, we will sustain the rejection of claims 1-3, 5, 7 and 9 under 35 U.S.C. § 103 as being unpatentable over Goss.

Turning to the rejection of claims 10, 11 and 14 under 35 U.S.C. § 103 as being unpatentable over Goss, independent claim 10 (as the appellants have argued) requires that ***each*** of

the receivers be removable and replaceable. Recognizing this, the examiner has taken the position that the claimed segments (formed by the slides or clasps P and the portion of the belt A to which they are attached) "may be made of multiple parts" since the slides or clasps P are disclosed as being located at "convenient distances on the belt A" (answer, page 3).

However, the mere fact that the slides or clasps P are disclosed as being located at spaced distances does not serve as a sufficient factual basis for establishing that the **segments**, which includes **both** the slides or clasps P **and** the portion of the belt A to which they are attached, may be formed of "multiple parts" as the examiner suggests. Indeed, the main supporting structure for Goss' cartridge belt and holder **is** the belt A and, if this belt was made of "multiple parts" (as would be necessary if the "segments" were made of multiple parts) as the examiner proposes, it does not appear that the device of Goss would function in the manner intended (**see Ex parte Hartmann**, 186 USPQ 366, 367 (Bd. App. 1974)). Accordingly, we will not sustain the rejection of claims 10, 11 and 14 under 35 U.S.C. § 103 as being unpatentable over

Goss.

Considering last the rejection of claims 4 and 15-19 under 35 U.S.C. § 103 as being unpatentable over Goss in view of Benward and Peckels, the appellants argue that there is no motivation to combine the teachings of the references in the manner proposed by the examiner. This is particularly the case, in the appellants' view, since:

The invention in Goss comprises a holder wherein the bottom of the holder incorporates a "groove or countersink . . . into which the head or rim of the cartridge fits and is **securely** held." (Col. 2, lines 27-29, emphasis added). Because, Goss already addressed and provided a solution for the problem of securely holding a cartridge, the addition of a tab to **further** secure the cartridge would be absolutely unnecessary. [Brief, page 10.]

We are unpersuaded by the appellants' arguments. While there must be some teaching, reason, suggestion, or motivation to combine existing elements to produce the claimed device (*see ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)), it is not necessary that the cited references or prior art specifically suggest making the combination (*B.F. Goodrich Co. V. Aircraft Braking Sys.*

Corp. ,

72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996) and **In re Nilssen**, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988)). Rather the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. **In re Young**, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and **In re Keller**, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

Goss clearly recognizes that it is of importance that the cartridge be "firmly and securely held" (page 1, column 1, line 22) in an upright position. Benward teaches an article holder having a **pair** of inwardly extending tabs 45 in order to insure that there is "no danger" of the article be held from "falling out of the holder" (column 2, lines 34 and 35). Peckels also teaches an article holder having an inwardly extending tab 24, 36 for the purpose of retaining the article being held in the holder. It is true, as the appellants have noted, that Goss discloses a retention means in the form of a groove or

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countersink (a) for retaining cartridges in the holder. Nevertheless, in view of the combined teachings of Goss, Benward and Peckels the artisan would have found it obvious as a matter of "common sense" (***see In re Bozek, supra***) to additionally provide the holder of Goss with an inwardly extending tab "for better retention" of the cartridge as the examiner has proposed. This is especially the case, in our view, since Goss expressly recognizes the need to firmly and securely hold the cartridge in the holder and Benward teaches a ***pair*** of retaining members (i.e.,

the inwardly extending tabs 45) should be provided in order to ensure that there is "no danger" of the article being held from "falling out of the holder." Accordingly, we will sustain the rejection of claims 4 and 15-19 under 35 U.S.C. § 103 based on the combined teachings of Goss, Benward and Peckels.

In summary:

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The rejections of claims 1-5, 7, 9 and 15-19 are affirmed.

The rejection of claims 10, 11 and 14 under 35 U.S.C. § 103 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

	Ian A. Calvert)	
	Administrative Patent Judge)	
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	James M. Meister)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
	Lawrence J. Staab)	
	Administrative Patent Judge)	

Douglas J. Christensen
Palmatier, Sjoquist, Helget & Voigt, P.A.
6600 France Avenue, South Suite 501
Minneapolis, MN 55435

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JMM/cam